

REMARKS/ARGUMENTS

Claims 1-21 remain in the application. Reconsideration of this application is respectfully requested.

Objection to the Specification

The Examiner has stated that the title is not descriptive. The specification has been amended to more clearly indicate the invention to which the claims are directed.

Claim Rejections - 35 U.S.C. § 102(a)

Claims 1-4 and 13-19 are rejected under 35 U.S.C. § 102(a) as being anticipated by USPN 6,163,697 (Peterson). Applicants, however, strongly disagree and respectfully traverse the rejections.

In short, MPEP § 2131 provides that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Contrary to the Examiner’s statement that all elements are disclosed in Peterson, elements relating to simulcast in the claims, namely first simulcast station, second simulcast station, third simulcast station, fourth simulcast station, simulcast messages, simulcast site controller, simulcast channel, simulcast stations, simulcast communication, simulcast site, first simulcast channel, second simulcast channel, and simulcast transmissions, are not disclosed in Peterson. Thus, the rejection is unsupported by the art and should be withdrawn.

Peterson provides for a method for assigning communication resources in a multi-site trunked radio communication system. A careful reading of this reference fails to disclose elements relating to simulcast. The examiner has cited various passages in Peterson in support of his rejection and has equated elements 101-104 in Peterson to be simulcast stations. However,

the examiner appears to be mistaken. Elements 101-104 in Peterson are “communication sites ... [having] one or more trunked base stations.” Peterson, col. 3 lines 20-31. Just because the trunked radio communication system is multi-site does not disclose elements relating to simulcast. As mentioned in numerous passages in Peterson, Peterson is directed to trunked radio communication systems. Peterson, col. 1 lines 18-25, col. 2 lines 7-31.

Based upon this lack of teaching, the Applicants insist that Peterson fails to describe the invention of the present application. Since Peterson fails to disclose essential limitations of the claimed invention, namely elements relating to simulcast, there is no anticipation under 35 U.S.C. § 102, because the exclusion of a claimed element from the prior art reference is enough to negate anticipation by that reference. For these reasons, the Applicants assert that the claims in the present application are not anticipated by Peterson and may therefore be passed to allowance.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 5-7 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson in view of USPN 5,867,488 (Derango). Applicants, however, strongly disagree and respectfully traverse the rejections.

In short, MPEP § 2141.03 requires that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Contrary to the Examiner’s statement that all elements are taught or suggested by Peterson in combination with DeRango, elements relating to simulcast in Claims 5-7 and 11 are not disclosed by the combination. Thus, the rejection is unsupported by the art and should be withdrawn.

The Examiner has stated that Peterson discloses communication over a simulcast channel. Office Action, April 13, 2004, pg. 5. However, as mentioned above, elements relating to simulcast are not taught or suggested by Peterson. Further, the Examiner admits that Peterson does not disclose a timestamp specifying when data will be transmitted. Office Action, April 13, 2004, pg. 5. The Examiner attempts to use DeRango to fill this void. Since Peterson does not

teach or suggest elements relating to simulcast, the Examiner's reliance on Peterson to teach or suggest simulcast is mistaken. Thus, the combination of Peterson with DeRango also fails to teach, suggest or make obvious the claimed invention of the present application.

Claims 8-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson in view of USPN 5,867,488 (DeRango as applied to claims 5-7 and further in view of USPN 5,802,454 (Goshay). Applicants, however, strongly disagree and respectfully traverse the rejections.

The Examiner has stated that Peterson discloses communication over a simulcast channel. Office Action, April 13, 2004, pg. 5. However, as mentioned above, elements relating to simulcast are not taught or suggested by Peterson. Further, the Examiner admits that Peterson in combination with Derango do not expressly teach internet protocol network and address. Office Action, April 13, 2004, pg. 5. The Examiner attempts to use Goshay to fill this void. Since Peterson does not teach or suggest elements relating to simulcast, the Examiner's reliance on Peterson to teach or suggest simulcast is mistaken. Thus, the combination of Peterson and DeRango with Goshay also fails to teach, suggest or make obvious the claimed invention of the present application.

Allowable Subject Matter

Claims 10 and 12 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form, including all other limitations of the base claim and any intervening claims. Since Claims 1-9, 11, and 13-19 should also be allowable, the Applicants believe that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicants. In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

Please charge any fees associated herewith, including extension of time fees, to Deposit Account 502117.

Respectfully submitted,

SEND CORRESPONDENCE TO:

Motorola, Inc.
Law Department

Customer Number: 22917

By: *Indira Saladi*

Indira Saladi
Attorney of Record
Reg. No.: 45,759
Telephone: 847.576.6735
Fax No.: 847.576.0721